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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,380	04/13/2001	David K. Rensin	OS-003C	3461
35856	7590	04/21/2005	EXAMINER	
LAVA GROUP LAW BY SMITH & FROHWEIN, LLC			OSMAN, RAMY M	
P.O. BOX 88148			ART UNIT	PAPER NUMBER
ATLANTA, GA 30356			2157	

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/834,380	RENSIN ET AL.
	Examiner	Art Unit
	Ramy M. Osman	2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 January 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5,9,11-15,19,21-25 and 29 is/are rejected.
- 7) Claim(s) 6-8,10,16-18,20,26-28 and 30 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Status of Claims

1. This communication is responsive to amendment filed 1/18/2005 where applicant amended claims 1,11 and 21.

Specification

2. The disclosure is objected to because of the following informalities: Applicant is requested to update page 8 lines 25-32.

Appropriate correction is required.

Claim Objections

3. Claim objected to because it was amended although the claim was not indicated as 'currently amended'.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 1 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Lines 8-10 state that the plug-in transfers information from the website to the appliance and that the transfer performs format conversion. However, according to page 13 of the disclosure and also to figure 1, it is the transcoding server that performs the format conversion and not the plug-in as stated in the claims. Therefore this feature is not enabled by the specification.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- ‘inserting an API in the web site’ gives the meaning that the API was not previously located on the website. The only other claimed element is the handheld appliance, and therefore it seems that the appliance is inserting the API into the website. However, this is not enabled by the specification. If this is not the implied meaning, then the claims are indefinite for failing to particularly point out and distinctly claim the invention.

- ‘inserting a user interface in the website’ gives the meaning that the user interface was not previously located on the website. The only other claimed element is the handheld appliance, and therefore it seems that the appliance is inserting the user interface into the website. However, this is not enabled by the specification. If this is not the implied meaning, then the claims are indefinite for failing to particularly point out

and distinctly claim the invention. The claim language is also in contradiction to what is shown in figure 1. Figure 1 shows the user interface being located on the transcoding server and not on the web site.

- ‘providing a software plug-in’ seems to imply that the plug-in is located on the website. The claim language is unclear and contradicts Figure 1 which shows the plug-in being located on the appliance.

8. Claims 9,19 and 29 recites the limitation "the second web site" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

10. Claims 1-5,11-15 and 21-25 rejected under 35 U.S.C. 102(a) as being anticipated by OmniSky (OmniSky Announces Release 2.0, Business Wire, October 16, 2000).

11. In reference to claims 1,11 and 21, OmniSky teaches the method, system, and handheld appliance for automatically transferring information from a website displayed on a handheld Internet appliance into a local database in the handheld appliance, comprising:

inserting an application program interface the web site for determining the information to be transferred; inserting a user interface in the web site for selecting a

plurality of options for transferring the information from the first web site into the handheld Internet appliance; and providing a software plug-in to automatically transfer the information from the web site into the local database in the handheld Internet appliance, the transfer performing all necessary format conversions and taking place independent from a synchronization operation (see OmniSky Announces Release 2.0, OmniSky discloses OneTap technology which enables Palm handheld mobile devices to access a website via a user interface. The user-interface allows the user, with a single tap, to download optimized web information into a user database.)

12. In reference to claims 2,12 and 22, OmniSky teaches the method, system and handheld appliance of claims 1,11 and 21 respectively, wherein the handheld Internet appliance comprises a wirelessly-enabled personal digital assistant (see OmniSky Announces Release 2.0, OmniSky discloses Palm handheld mobile devices).

13. In reference to claims 3,13 and 23, OmniSky teaches the method, system and handheld appliance of claims 2,12 and 22 respectively, wherein the handheld Internet appliance further comprises plurality of local applications, the plurality of local applications comprising:

an address book application; calendar application; an e-mail application; memo pad application; to-do list application; web browser application; word processing application; and spreadsheet application (see OmniSky Announces Release 2.0, OmniSky teaches downloading into databases like an address book, date book or memo pad).

14. In reference to claims 4,14 and 24, OmniSky teaches the method, system and handheld appliance of claims 1,11 and 21 respectively, wherein local database stores a plurality of data records representing information entered by the user when interacting

with a local application in the handheld Internet appliance (see OmniSky Announces Release 2.0, OmniSky teaches databases like an address book, date book or memo pad, which are all applications that inherently store user records).

15. In reference to claims 5,15 and 25, OmniSky teaches the method, system and handheld appliance of claims 1,11 and 21 respectively, wherein inserting the user interface in the web site comprises inserting a button in the web site, the button comprising a menu displaying menu options for transferring the information from the web site into the handheld Internet appliance (see OmniSky Announces Release 2.0, OmniSky teaches OneTap technology which enables users to do a single tap of a button for downloading web information).

Allowable Subject Matter

16. Claims 6-8,10,16-18,20,26-28 and 30 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: wherein the menu options have an option for launching a second website displaying content associated with the information from the already open website.

Response to Arguments

17. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

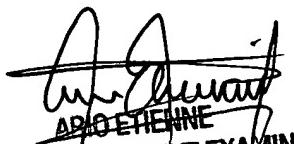
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramy M. Osman whose telephone number is (571) 272-4008. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RMO
April 17, 2005


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